

## **REMARKS**

The amendment above and remarks below, which are being submitted under 37 C.F.R. § 1.111, are responsive to the non-final Office action dated August 23, 2005 on the above-identified patent application. Claims 1-25 and 32-35 are pending in the application. Claims 26-31 were canceled previously in response to a restriction requirement. In the Office action, the Examiner rejected each of the pending claims under 35 U.S.C. § 102 or § 103 as being anticipated by, or obvious over, U.S. Patent No. 5,545,162 to Huebner ("Huebner").

Applicants traverse the rejections, contending that rejected claims 1-25 and 32-35 are neither anticipated nor obvious. Nevertheless, to expedite the issuance of a patent, and to more particularly point out and distinctly claim aspects of the invention that applicants would like to patent now, applicants have amended claims 1, 3, 8, 10, 13, 17-19, and 21-23; canceled claims 2, 7, 12, 14-16, 20, 25, and 32-35, without prejudice; and added new claims 36-52. Applicants reserve the right to pursue the canceled or amended claims in their original form at a later time. Furthermore, applicants have presented arguments showing that claims 1, 3-6, 8-11, 13, 17-19, 21-24, and 36-52 are patentable. Accordingly, applicants respectfully request reconsideration of the rejected claims, and prompt issuance of a Notice of Allowability covering all of the pending claims.

### **I. Information Disclosure Statement**

In the Office action, the Examiner requested a paper copy of an Information Disclosure Statement allegedly filed by the Applicants. More particularly, the Examiner indicated that he had considered the references listed in an Information Disclosure

Statement filed November 18, 2004, but did not have the corresponding paper copy to initial.

Applicants believe that they have filed only two Information Disclosure Statements for the present application, on August 17, 2004, and on February 28, 2005. Copies of the PTO-1449 forms for each of these two Statements were attached to the Office action (and were initialed as being considered). Applicants believe that they did not file a third Information Disclosure Statement for the present application that corresponds to the set of references dated November 18, 2004. In support of this suggestion, applicants checked the Patent Office's PAIR site and did not find a file-wrapper entry corresponding to this third Information Disclosure Statement. It is possible that a third party submitted the third Information Disclosure Statement, for a different application, and that it inadvertently was connected to the present application.

**II. Amendments to the Claims**

The present communication makes a number of amendments to the pending claims, including amendment of claims 1, 3, 8, 10, 13, 17-19, and 21-23, and addition of new claims 36-52. Each amendment to the claims is fully supported by the application as filed. Exemplary support for each of the claim amendments is presented in the following table.

<b>Claim</b>	<b>Exemplary Support in Application</b>
1	Figures 2 and 10; Page 12, line 20 to Page 13, line 4; Page 23, line 19 to Page 24, line 2
3	Original claim 3
8	Original claim 7

<b>Claim</b>	<b>Exemplary Support in Application</b>
10	Original claim 1; Page 12, line 20 to Page 13, line 4; Page 14, lines 7-11
13	Figure 10; Page 12, line 20 to Page 13, line 4
17	Figure 9; Page 12, line 20 to Page 13, line 4; Page 14, lines 7-11
18	Original claim 10
19	Figures 2 and 3
21	Page 13, lines 1-5
22	Figure 1; Page 11, lines 13-15 and 19-20
23	Figures 3, 4, 6, and 7; Page 16, lines 13-17; Page 17, line 16 to Page 18, line 13
36	Original claim 8; Figure 3
37	Original claim 1; Figures 3 and 9 Page 12, line 20 to Page 13, line 4;
38	Original claim 3
39	Figures 1 and 2; Page 13, lines 6-13
40	Figure 2
41	Figure 2; Page 13, lines 15-18
42	Page 13, lines 1-5
43	Page 12, line 20 to Page 13, line 4
44	Figures 3, 4, 6, and 7; Page 16, lines 13-17; Page 17, line 16 to Page 18, line 13
45	Figure 9
46	Original claim 1; Figures 2, 3 and 10; Page 12, line 20 to Page 13, line 4
47	Figure 2
48	Figure 2; Page 13, lines 15-18

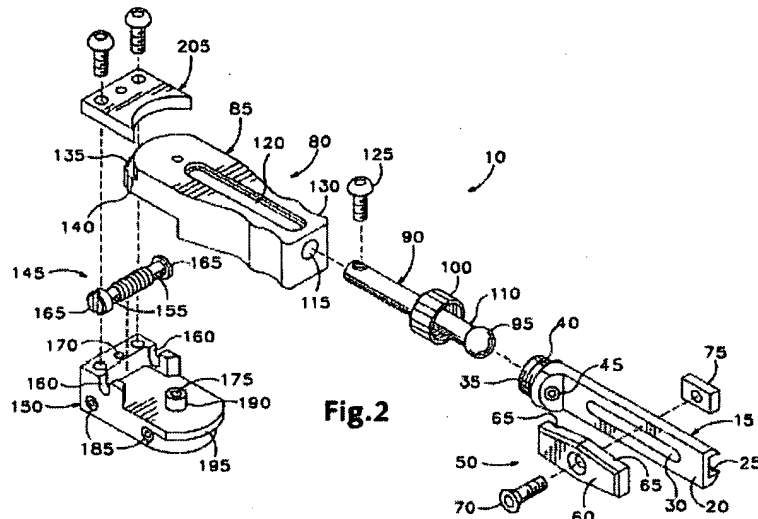
Claim	Exemplary Support in Application
49	Page 13, lines 1-5
50	Page 12, line 20 to Page 13, line 4
51	Figures 3, 4, 6, and 7; Page 16, lines 13-17; Page 17, line 16 to Page 18, line 13
52	Original claim 9

### **III. Claim Rejections under 35 U.S.C. § 102**

The Examiner rejected claims 1-11, 13-20, 22-25, and 32-35 under 35 U.S.C. § 102(b) as being anticipated by Huebner. Applicants traverse these rejections. However, applicants have amended claims 1, 3, 8, 10, 13, 17-19, and 21-23; and have canceled claims 2, 7, 14-16, 20, 25, and 32-35, without prejudice. Each of claims 1, 3-6, 8-11, 13, 17-19, 21-24, and new claim 36 is patentable for the reasons set forth below.

#### **A. The Huebner '162 Patent**

Huebner discloses an external fixator for the wrist (see Figure 2 below). The fixator has a ball-and-socket joint that allows the fixator to bend at a single position along the fixator, which is defined by the center point of the ball. Huebner does not disclose any flexible components (absent articulation) and/or resilient components for the coupling of the fixator. The coupling disclosed by Huebner thus does not have resiliency or a resilient response to flexion, a capability to flex at a plurality of positions along the fixator, a flexible elongate member, or a flexible wire, among others.



**B. Claims 1, 3-6, 8, and 9**

**Independent claim 1 is directed to a bone fixator:**

1. (Currently Amended) A bone fixator for repairing fractures and/or other dislocations of a distal radius and wrist, comprising:

at least one distal mounting element configured to be mounted in a metacarpal bone;

at least one proximal mounting element configured to be mounted in the radius;

a distal member, configured to secure the distal mounting element relative to the distal member;

a proximal member, configured to secure the proximal mounting element relative to the proximal member; and

a coupling connecting the proximal member and the distal member, wherein the coupling is configured to permit immobilization, as well as adjustable flexion, rotation, and translation of the distal member relative to the proximal member, wherein the coupling includes a substantially linear, flexible wire that allows the coupling to flex at a plurality of positions along the wire, and wherein the coupling has a resiliency provided at least mostly by the wire.

Huebner does not teach or suggest every element of amended claim 1. For example, Huebner does not teach or suggest a coupling that includes a wire or that has a resiliency and particularly not a coupling that includes “a substantially linear, flexible wire” or “a resiliency provided at least mostly by the wire.” Claim 1 thus should be allowed. Claims 3-6, 8, and 9, which depend from claim 1, also should be allowed for at least the same reasons as claim 1.

C. Claims 10, 11, 13, 17-19, 21-24, and 36

Independent claim 10 is directed to a bone fixator:

10. (Currently Amended) A bone fixator for repairing fractures and/or other dislocations of a distal radius and wrist, comprising:

at least one distal mounting element configured to be mounted in a metacarpal bone;

at least one proximal mounting element configured to be mounted in the radius;

a distal member, configured to secure the distal mounting element relative to the distal member;

a proximal member, configured to secure the proximal mounting element relative to the proximal member; and

a coupling configured to connect the proximal member and the distal member,

wherein the coupling ~~includes a portion capable of superelastic flexion~~ **is configured to permit immobilization, as well as adjustable flexion, rotation, and translation of the distal member relative to the proximal member, wherein the coupling has a resiliency that allows the coupling to respond resiliently to flexion, and wherein the coupling has a permitted range of flexion that is adjustable without affecting the resiliency.**

Huebner does not teach or suggest every element of amended claim 10. For example, Huebner does not teach or suggest a coupling with “a resiliency that allows the coupling to respond resiliently to flexion” and particularly not a coupling with “a permitted range of flexion that is adjustable without affecting the resiliency.” Claim 10 thus should be allowed. Claims 11, 13, 17-19, 21-24, and 36, which depend from claim 10, also should be allowed for at least the same reasons as claim 10.

**IV. Claim Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 12 and 21 under 35 U.S.C. § 103(a) as being obvious over Huebner. However, claim 12 has been canceled. In addition, claim 21 should be patentable for depending from allowable claim 10. Therefore, the rejections under 35 U.S.C. § 103 should be moot.

**V. New Claims 36-52**

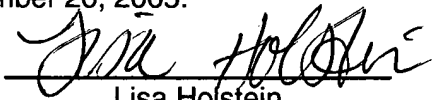
The present communication adds new claims 36-52. Each of these claims is patentable over Huebner. Claim 36 is allowable for depending from allowable claim 10. Claim 37 is an independent claim directed to a bone fixator and should be allowable for reciting, for example, a flexible wire that “creates a flexible portion of the coupling” that “extends along a minor fraction of the length of the fixator.” Claims 38-45, which depend from claim 37, should be allowed for at least the same reasons as claim 37. Claim 46 is an independent claim directed to a bone fixator and should be allowable for reciting, for example, that “the coupling also includes a plurality of annular spacers received on the elongate member and engaged with one another.” Claims 47-52, which depend from claim 46, should be allowed for at least the same reasons as claim 46.

**VI. Conclusion**

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If there are any questions regarding this communication, or if a telephone interview would in any way advance prosecution of the application, the Examiner is encouraged to contact the undersigned attorney of record, James R. Abney, or his associate Stanley M. Hollenberg.

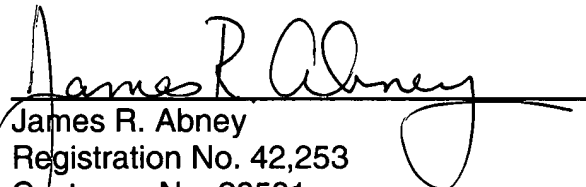
**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on December 20, 2005.

  
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